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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,700	01/18/2002	Hans-Werner Schmidt	I-22531/US/AO/UBT2/PCT	1004

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PATENT DEPARTMENT  
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EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/914,700

Applicant(s)

SCHMIDT ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,4-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 5, 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 6-9, 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of a composition comprising a crystallizable thermoplastic polymer and a nucleating agent of formula (1) in the reply filed on May 10, 2004 is again acknowledged. In the election applicant elected the following substituent groups on the compound of formula (1):

A is a substituted or unsubstituted triphenylamine

B is an amide unit

X is an aromatic ring compound which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen

B' is acetamide

X' is an aromatic ring compound which may be substituted with nitrogen, sulfur, sulfonyl, sulfonyl, oxygen

Applicant elected the ultimate species of tris[3,4-bis(decyloxy)phenylene-carbonylimino-1,4-phenylene]amine. Applicant indicated that claims 1-9 and 12 read upon the elected ultimate species. However, upon reconsideration it is not clear that claim 5 reads upon the elected species. Claim 5 is withdrawn from consideration.

The requirement is still deemed proper and is therefore still FINAL.

Claims 5 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Art Unit: 1714

Applicant timely traversed the restriction (election) requirement in the reply filed on May 10, 2004.

1. However, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Examination has been extended beyond the elected species.
- 3.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Substituents X, X' and B' are not defined by structure, only by their compatibility with the polymer. It is unclear what applicant intends these moieties to be.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 4, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck, US Patent No. 4076910.

8. Beck discloses a composition of a crystallizable thermoplastic polymer and nucleating agent wherein the nucleating agent conforms to applicant's formula (1). Applicant's attention is particularly directed to melamine and the aminopyridine compounds used as nucleating agent. Applicant's formula (1) includes these compounds. The nucleators are used in an amount of 0.005 to 1.0 % by weight based upon the polymer. The nucleator increases the crystallization temperature of the polymer and since the nucleators are the same as applicant's, it is inherent that the crystallization temperature is increased by at least 3 degrees C. Likewise, the decrease in polymer spherulite size by 50% is an inherent result attributable to the function of the nucleator employed. The patented compositions may be formed into films, fibers, rods and tubes. No patentable difference is readily ascertained between present and patented compositions. See col. 1, line 1 through col. 2, line 68 and col. 3, line 28 through col. 4, line 50.

9. Claims 2, 4-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Voeks, US Patent No. 3367926.

Art Unit: 1714

10. Voeks also discloses a composition of a crystallizable thermoplastic polymer and nucleating agent wherein the nucleating agent conforms to applicant's formula (1). Applicant's attention is particularly directed to compounds used as nucleating agent in Tables 3 and 7. Applicant's formula (1) includes these compounds. The nucleators are used in an amount of 0.005 to 1.0 % by weight based upon the polymer. The nucleator increases the crystallization temperature of the polymer and since the nucleators are the same as applicant's, it is inherent that the crystallization temperature is increased by at least 3 degrees C. Likewise, the decrease in polymer spherulite size by 50% is an inherent result attributable to the function of the nucleator employed. The patented compositions may be formed into films, fibers, rods and tubes. No patentable difference is readily ascertained between present and patented compositions. See col. 1, line 9 through col. 2, line 44 and col. 3, line 5 through col. 4, line 37.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck, US Patent No. 4076910 as applied to claims 2, 4, 8 and 9 above.

13. Claims 2-4, 6-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voeks, US Patent No. 3367926.


Art Unit: 1714

14. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to select any of the nucleators of either Beck or Voeks and employ them in the disclosed thermoplastic resins in an amount ranging from 0.005 to 1.0 % by weight based upon the weight of the polymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kriellion A. Sanders  
Primary Examiner  
Art Unit 1714

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